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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

**HOE-790**

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on January 3, 2008

Signature Carol Prentice

Typed or printed name Carol Prentice

Application Number  
**10/731,284**

Filed  
**12/09/2003**

First Named Inventor  
**Nesper, et al.**

Art Unit  
**3733**

Examiner  
**R. Shaffer**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.  
☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 37,886

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

**Douglas M. McAllister**  
Typed or printed name

**(203)459-0200**  
Telephone number

**January 3, 2008**  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
Nesper, et al. ) Examiner: R. Shaffer  
)  
Serial No.: 10/731,284 ) Art Unit: 3733  
)  
Filed: December 9, 2003 )  
)  
For: **IMPLANT FOR FIXING ADJACENT BONE PLATES**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Signature: *Carol Prentice*

Carol Prentice

**SUMMARY OF ARGUMENTS**  
**FOR PRE-APPEAL BRIEF REVIEW CONFERENCE**

Dear Sir:

This Summary of Arguments is being filed simultaneously with a Notice of Appeal and a Pre-Appeal Brief Request for Review in connection with the final Office Action mailed on October 4, 2007 and the Advisory Action mailed on December 21, 2007.

**Background**

In response to the final Office Action, Applicant's undersigned counsel conducted a telephone interview with the Examiner on November 29, 2007. The telephone interview is summarized in Applicant's Response filed on December 6, 2007 (mailed December 4, 2007). The Examiner issued an Advisory Action on December 21, 2007 maintaining the rejection of the claims set forth in the final Office Action in view of Lerch (DE 199 52 359). However, the Examiner has indicated in the Advisory Action that the Response overcomes the double patenting rejection set forth in the final Office Action.

Accordingly, the following rejections set forth in the final Office Action remain outstanding:

Claims 1-11, 13-24, 27 and 28 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Lerch (DE 199 52 359 C1).

Claim 12 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Lerch in view of Akerfeldt (US 6,508,828) and Bonutti (US 6,045,551).

Claims 1-19 and 22-33 are pending. Dependent claims 25, 26 and 29-33 are withdrawn. Applicants respectfully submit that upon the allowance of independent claim 1, withdrawn dependent claims 25, 26, and 29-33 should also be allowed.

#### Discussion of § 102(b) Rejections in View of Lerch

Claims 1-11, 13-24, 27 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lerch. This rejection is respectfully traversed. An anticipation rejection requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Lerch does not meet the requirements for an anticipation rejection.

DE 199 52 359 C1 to Lerch has a U.S. counterpart, US 2002/0156475 A1 as identified in Applicant's Information Disclosure Statement filed with the present application. In the discussion below, references are made to the U.S. counterpart of Lerch rather than the German language reference.

Claim 1 specifies that one or more hook elements are provided for fixing the at least one tension band fixable relative to the outer abutment element and that the at least one tension band is fixable relative to the outer abutment element by penetration of the one or more hook elements into the at least one tension band.

As discussed with the Examiner during the November 29, 2007 telephone interview, Lerch does not disclose or remotely suggest a hook element that can penetrate into the tension band for fixing the tension band relative to an outer abutment element, as claimed by Applicants.

The Examiner identifies the reference numerals 54, 72 of Lerch as hook elements (see, Final Office Action, page 4). However, reference numeral 54 of Lerch denotes a peg element on which the thread or wire 28 is wound around (Para. 0095) and reference numeral 72 of Lerch is a clamping seat which is formed as a fixing recess into which the thread or wire 28 can be clamped in order to fix the thread or wire in relation to a second bearing element 66 (Para. 0097).

The Examiner asserts that the surface roughness of the wedge-like recess 72 would partially penetrate into the thread to prevent it from slipping (Office Action, sentence bridging pages 4-5). During the telephone interview the Examiner explained this reasoning further, indicating that at the microscopic level the roughness of the surface of the recess 72 would penetrate into the thread 28. In the Advisory Action, the Examiner states that “The opening and the tension band when pressed against will have a structure penetrating within each other (to some degree).”

Applicants respectfully disagree with the Examiner’s overly broad reading of the reference. There is simply no disclosure in Lerch that suggests that the surface of the recess 72 is rough. Further, one skilled in the art would appreciate that the clamping action of Lerch comes from the wedge-like shape of recess 72, and not from any surface roughness of the recess. In fact, if indeed the thread of Lerch was actually fixable to the surface of the opening via the surface roughness of the opening or due to the fact that the thread and opening “will have a structure penetrating within each other (to some degree)” as stated by the Examiner, then there would be no need in Lerch to provide the wedge shape to the opening. However, one skilled in the art would of course readily appreciate that the wedge-shaped opening 72 of Lerch fixes the thread due to a clamping action and not due to any surface roughness.

In addition, the use of a recess to fix a thread via a clamping action is directly contrary to the use of a hook element to fix a thread via penetration into the thread, so that Lerch can be seen to teach away from Applicants’ claimed invention. In Lerch, the thread is clamped by the recess 72 so that the sides of the recess partially surround the thread, while with Applicants’ claimed invention, the hook element penetrates into the tension band so that the band surrounds the hook element.

Simply put, the opening or recess 72 which clamps the thread of Lerch is far removed from Applicants' claimed hook element which penetrates into the tension band. One skilled in the art would recognize the significant difference in the design of the connecting element of Lerch and the design of the implant claimed by Applicants.

Accordingly, Lerch does not disclose or remotely suggest the use of a tension band and fixing the tension band relative to the outer abutment element with one or more hooks which penetrate into the tension band, as claimed by Applicants.

As Lerch does not disclose each and every element of the invention as claimed, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc., supra*.

Applicants respectfully submit that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Lerch, taken alone or in combination with any of the other prior art of record.


Further remarks regarding the asserted relationship between Applicants' claims and the prior art are not deemed necessary, in view of the foregoing discussion. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Withdrawal of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

Reconsideration and allowance of this application at a Pre-Appeal Brief Review conference is respectfully requested. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,

  
Douglas M. McAllister  
Attorney for Applicant(s)  
Registration No.: 37,886  
Lipsitz & McAllister, LLC  
755 Main Street  
Monroe, CT 06468  
(203) 459-0200

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